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12/23/2002

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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 12/23/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/637,242

Examiner

Jessica L. Rossi

Applicant(s)

ST. JOHN, CALI

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/7/02, RCE, paper no. 7.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *copy of claims from 09/951,723*.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on 11/7/02 for a RCE under 37 CFR 1.114 based on parent Application No. 09/637242 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. This action is in response to the amendment dated 11/7/02. Claims 16-17 were added. Claims 1-17 are pending.

3. The rejection of claims 1-2, 5-10 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over Bjornsen (of record) in view of Blotky et al. (of record) and the Admitted Prior Art in the specification of the present application, as set forth in paragraph 5 of the previous office action (paper no. 5), has been withdrawn due to the added limitation of the protective members being consumer removed, flexible, and collectable.

4. The rejection of claims 1-8 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over Granofsky (of record) in view of the collective teachings of Bjornsen, Saliba et al. (of record), and Stasiuk (of record), Blotky et al. and the Admitted Prior Art, as set forth in paragraph 8 of the previous office action, has been withdrawn for the reason stated above.

5. Support for the amendment can be found on p. 1, lines 10-11 and p. 12, line 25.

### ***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 4-5, 12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer (US 4402421) in view of Granofsky (US 5108003; of record), and the collective

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teachings of Blotky (US 6084526; of record) and Bozlee (US 6354645), **or alternatively**, Granofsky in view of Ruemer taken with the above cited references.

With respect to claims 1-2, Ruemer, directed to a protective member 10 for a beverage container, teaches manufacturing a consumer removed, flexible and collectable protective member and attaching promotional indicia (Figure 6) to the protective member (column 2, lines 49-58; column 5, lines 40-52). The reference is silent as to conveying by revenue producing sale a right to attach the indicia to the protective member and adhering the protective members to the container

It is known in the art to display advertising/promotional information on beverage and food containers wherein this information can be related to other products made by the company selling the container, or alternatively, **the information can concern an unrelated product (product sold by another company)**, as taught by Blotky et al. (column 1, lines 6-7; column 2, line 23; column 4, lines 1-2 and 12-18). Furthermore, it is known to engage in a **method of doing business** wherein the producer of a product gives a third party the right to advertise its products or services on the producer's product by selling these rights to the third party to generate revenue, as taught by Bozlee (Figure 2; column 3, lines 1-5 and 22-26 and 36-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a business method by conveying by revenue producing sale the right to attach the indicia to the protective members of Ruemer by selling the right to third parties because such is known, as taught by the collective teachings of Blotky and Bozlee, wherein this practice is a source of revenue for the inventors that can offset the cost of the invention.

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Ruemer teaches attaching the peripheral edge 14 of the protective member to the container by means of a flanging operation (Figure 4; column 3, lines 37-39) where the protective member includes a retractable tab portion (column 2, lines 36-39). It is known in the art to attach a flexible protective member 10, which includes a retractable tab portion, to a container 11 using an adhesive, as taught by Granofsky (Figures 4-5; column 1, lines 5-9 and 20-22; column 2, lines 15-26 and 50-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive in addition to or as an alternative to the flanging operation to attach the protective member of Ruemer to the container because such is known in the art, as taught by Granofsky, where this would ensure that the protective member and container do not become disassembled during shipping or handling.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach promotional indicia to the protective members of Granofsky because such is known in the art, as taught by Ruemer, and this provides the inventors with a marketing tool that peaks consumer curiosity which increases the chances of the consumer purchasing the product.

It is noted that Granofsky teaches that the protective member does not completely separate from the container so that littering is avoided (column 3, lines 28-30); however, Ruemer also teaches that the protective member can stay attached to the container to avoid litter (column 2, lines 56-58) but can be removed to redeem a prize if the promotional indicia indicates that a prize has been won (column 2, lines 54-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the protective member of Granofsky capable of being completely separated from the container while also being capable of remaining

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attached to the container because such is known in the art, as taught by Ruemer, and this allows for prize redemption or litter avoidance depending on whether or not a prize is won.

Regarding claim 4, Ruemer is silent as to sanitizing the mouth contact portion of the container. It would have been obvious to do so because such is known in the art, as taught by Granofsky (column 3, lines 1-5), where this ensures a clean contact portion for the user upon removal of the protective member.

Regarding claim 5, Ruemer teaches the indicia being for promotional and redeemable purposes (column 2, lines 49-51).

Regarding claim 12, Granofsky teaches adhering the protective members to the containers using adhesive (column 2, lines 50-52).

Regarding claim 14, Ruemer is silent as to treating the protective members with an anti-static chemical. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective members with an anti-static chemical to ensure that the members separate easily so as to not impede the manufacturing process.

Regarding claim 15, Ruemer is silent as to treating the adhesive so that it bonds more strongly to the member and less strongly to the can. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the adhesive so that it bonds more strongly to the member and less strongly to the can so that the member can be easily removed by the consumer without the adhesive separating from the member and remaining on the can resulting in an unsanitized mouth contact portion.

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8. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Cummings (US 4514248).

Regarding claim 3, selection of a particular shape for the protective members would have been within purview of the skilled artisan. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an hourglass shape because it is known in the art to adhesively attach protective members to liquid containers, where the protective members have an hourglass shape, include a tab portion, and have indicia printed thereon, as taught by Cummings (Figure 3; column 3, lines 25-30 and 45-47 and 64-66; column 4, lines 32-39).

Regarding claim 16, it is noted that this claim is a combination restating all the limitations in claims 1 and 3.

9. Claims 6, 9-11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Bjornsen (US 6296137; of record).

Regarding claim 6, Ruemer is silent as to printing the indicia. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the indicia on the protective member of Ruemer because such is known in the art, as taught by Bjornsen (column 3, lines 29-31), where only the expected results would have been achieved.

Regarding claim 9, Ruemer teaches the indicia being applied to the underside of the protective member (column 2, lines 45-49).

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Regarding claim 10, Ruemer is silent as to the protective member being opaque. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an opaque protective member because such is known in the art, as taught by Bjornsen (column 3, lines 35-38), where only the expected results of preventing the user from seeing the indicia printed on the underside would have been achieved.

Regarding claim 11, Ruemer teaches the indicia being for promotional and redeemable purposes (column 2, lines 49-51).

Regarding claim 17, it is noted that this claim is a combination restating all the limitations in claims 1 and 9-11.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), the collective teachings of Blotky and Bozlee, and Bjornsen as applied to claim 6 above, and further in view of Burns (US 6127437).

Regarding claim 7, Ruemer is silent as to treating the protective member to accept and retain printing ink. Treatment of the protective member would depend on the type of material used for the member, which would dictate its ability to retain printing ink. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective member of Ruemer because it is known to treat plastic closure members for beverage containers to prepare their surface for retaining printed matter, as taught by Burns (column 5, lines 46-65).

Regarding claim 8, Burns teaches the treatment being by corona discharge (column 5, lines 61-63).



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11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Takayama (US 6015059).

Regarding claim 13, Granofsky is silent as to the adhesive being antibacterial. It would have been obvious to use an antibacterial adhesive because such is known in the art, as taught by Takayama (column 3, lines 12-16), and would prevent any contaminants from coming into contact with the consumer's mouth.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-3, 4-7, and 11-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 10-13, and 18-23 of copending Application No. 09/951,723 <sup>Went Abandoned</sup> in view of Ruemer.

The copending application teaches all the limitations of claim 1 except the protective member being consumer removed, flexible and collectable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the protective member having such attributes because such is known in the art, as taught by Ruemer, and this provides

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the inventors with a marketing tool that peaks consumer curiosity which increases the chances of the consumer purchasing the product.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

14. Applicant's arguments filed 11/7/02 have been fully considered but they are not persuasive.

15. On page 6 of the arguments, Applicants argue that Blotky teaches an electronic device that bears no resemblance to the specification and drawings of the present application.

The examiner points out that Blotky was only used to show known that it is known in the art to display advertising/promotional information on beverage and food containers wherein this information can be related to other products made by the company selling the container, or alternatively, the information can concern an unrelated product (product sold by another company).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

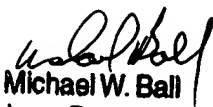
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi  
Patent Examiner  
Art Unit 1733



jl  
December 19, 2002



Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700